

## **REMARKS**

### **I. Prosecution History**

Claims 1-13 were presented for examination by Applicant's filing of a nonprovisional application on January 16, 2004. Under the first non-final Office Action, dated October 4, 2007, claims 1-13 were rejected under 35 U.S.C. 102(e) as being anticipated by Murren et al. (US Pub No 2003/0110085). Applicant amended claims 1, 6, 12 and 13 and requested reconsideration of the application.

Claims 1-13 were then finally rejected in a final Office Action, dated April 29, 2008, under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (2002/0007374). Applicant canceled claims 7 and 8 and amended claims 6, 9, 10, 11 and 12 to place the application in condition for allowance.

Under the Office Action, dated July 24, 2008, claims 1-13 were rejected and the amendments to claims 6 and 12 were not entered. The Examiner maintained the rejection to claims 1-13 under 35 U.S.C. §103(a) as being upatentable over Murren in view of Marks. Applicant filed a Request for Continued Examination.

Under the Non-Final Office Action, dated December 3, 2008, the finality of the previous office action was withdrawn and amendments submitted by Applicant on August 28, 2008, were entered. Claims 1-13 were rejected as being unpatentable over Murren in view of Marks.

Under the Office Action, made final, dated June 5, 2009, claims 1-6 and 9-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks and instant invention background. On March 2, 2009, Applicant Requested for Continued Examination, along with amendments to the claims 1-6 & 9-15, cancellation of claims 7 & 8, and added new claims 16 and 17.

Under the Non-Final Office Action, dated October 28, 2009, the finality of the previous office action was withdrawn and amendments submitted by Applicant on October 1, 2009, were entered. Claims 2-6 & 9-15 were cancelled and previously rejected claim 1 and new claims 16 & 17 were rejected as being unpatentable over Murren in view of Marks and instant invention background.

Claims 1 and 16 were amended to further limit the claimed invention by adding the limitation "wherein communication is all accomplished via multicast to subscribers by publisher enterprise equipment." The applicant drew the Examiners attention to paragraph [0002] which states that the Marks et al. invention "relates to a method and apparatus for supporting a multicast response to a unicast request to a document." The Applicant argued that by adding the phrasing "wherein communications is all accomplished via multicast to subscribers" that the prior art was required to possess multicasting throughout the communication schema in order to disclose the claimed invention.

Under the Office Action, made final, dated April 1, 2010, claims 1, 16, and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks and instant invention background. The Applicant filed a response to the Office Action on May 28, 2010.

Under the Advisory Action dated June 7, 2010, claims 1 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks and instant invention background. The Applicant filed amendments to the pending claims, a response, and a Request for Continued Examination on July 12, 2010.

Under the Non-Final Office Action, dated August 17, 2010, claims 1 and 16 stand rejected under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement, and 35 USC §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the Applicant regards as the invention. Claims 1 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks and instant invention background. The Applicant herein files amendments to the pending claims and requests reconsideration in this response.

## **II. Claim Rejections – 35 U.S.C. §112, First Paragraph**

Claims 1 and 16 stand rejected under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner argues that the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. The Examiner further argues that the specification contains no reference to a multicast communication transport layer that is able to facilitate multi-site print load balancing. The Examiner asserts that the print server gauges the print load balancing on the respective sites and decides whether to send jobs to these sites for output as disclosed in Applicant's specification paragraph [006]. In addition, the Examiner argues that Applicant's specification does not disclose facilitating load balancing through instant synchronization of print service sites.

The Applicant herein amends claims 1 and 16 accordingly. The Applicant amends both claims from "using a multicast communication transport layer" to "using a print server" to facilitate multi-site print load balancing. The Applicant further defines said print server's function by adding that a print server gauges and determines respective printing sites' print load capacity, expertise required to print, shipping and labor costs when facilitating said multi-site print load balancing". These functions are disclosed in Applicant's paragraph [006] and no new matter is added. Further, the Applicant cancels the portion of claims 1 and 16 that refers to instant synchronization. The Applicant respectfully requests withdrawal of the rejections and reconsideration of amended claims 1 and 16.

### **III. Claim Rejections – 35 U.S.C. §112, second paragraph**

Claims 1 and 16 stand rejected under 35 USC §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the Applicant regards as the invention. The Examiner argues that that claim language of "a multicast communication transport layer to facilitate multi-site print load balancing" renders the claim indefinite. The Examiner questions whether the intent of this language is to have the multi-cast communication layer perform multi-site load balancing, or to have the print service CPU perform this function.

The Applicant herein amends claims 1 and 16 accordingly to disclose the print server facilitating multi-site print load balancing, rather than the multicast communication layer performing this function. The Applicant respectfully requests withdrawal of the rejections and reconsideration of amended claims 1 and 16.

#### **IV. Claim Rejections – 35 U.S.C. §103**

##### ***Requirements for Prima Facie Obviousness***

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (KSR Int'l v. Teleflex Inc.) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a reason that would have prompted a person to combine the elements and to make that analysis explicit. MPEP §2143 sets out the further basic criteria to establish a prima facie case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a prima facie showing of obviousness by the examiner (assuming there are no objections or other grounds for rejection) and of a prima facie showing by the examiner of a reason to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

### ***Murren in view of Marks***

Claims 1 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (US Pub No. 2002/0007374) and the background of the invention.

Regarding claim 1, the Examiner argues that Murren discloses maintaining synchronization of information published to multiple subscribers, comprising: publishing print-ready document library subject availability via multicast communication over a data network using a multicast communication transport layer wherein said subject availability is predefined; receiving subscriptions for print-ready document library subjects via point-to-point data communication over the data network from remote subscribers at individual sites wherein said subscriptions comprise a configuration file that functions as a lookup table for subjects subscribed to by subscribers; instantaneously, at time of repository change, synchronizing data representative of the print-ready document with remote subscribers at individual sites over the data network using a multicast communication transport layer; and printing said print ready document at said individual sites.

Regarding claim 16, the Examiner argues that Murren discloses a system for managing distributed multi-site Print Ready Document libraries comprising: at least one database; at least one print ready document library wherein documents are assigned to predefined topics stored within said at least one database; a data network configured to publish availability of said predefined topics to a plurality of print service sites wherein said print service sites subscribe to at least one of said predefined topics utilizing a configuration file conveyed over said data network; at least one server configured to access said predefined topics stored within said at least one database; enterprise communication equipment comprising a router and a network access device utilizing a multicast communication transport layer configured to automatically send print-ready documents to said plurality of print service sites in accordance with said predefined topics that each of said plurality of print service sites subscribed to; publish-subscribe middleware configured to enable said at least one server to operate in conjunction with said at least one database in order to manage subscriber data, topic data and publication-subscription logs; at

least one rendering device located at each of said print service sites configured to render said print-ready documents.

However, the Examiner admits that both Murren et al. and Marks fail to disclose a print-ready document, and continues with the assertion that this is well known in the art as evidenced by the background of the invention. The Examiner further argues that the background of the invention discloses already print formatted matter documents that may be transmitted to a printer directly, which eliminates a need to repeat conversion and decomposition process of another copy if desired. Therefore, the Examiner continues, it would have been obvious to one of ordinary skill at the time of invention to have a print ready document incorporated in the device of Murren, as modified by the features of Marks, in order to eliminate the need to repeat the conversion or decomposition process if another copy of the document is needed. The Examiner further argues that Murren discloses a system for managing distributed multi-site Print Ready Document libraries as detailed in claim 16 above and further argues that Murren discloses instantaneously synchronizing data representative of said print-ready document with said plurality of print service sites over the data network. Specifically, the Examiner argues that once changes are made to the database storing the information regarding the interested subscribers, the information is propagated out, via the publication component (citing 110) to the various subscribers (citing 104) who may be affected by the change in information. The Examiner continues that all subscribers that are concerned with the information that is subscribed to be notified of the change in the information related to their criteria. The Examiner continues that the information relating to the criteria and with the multiple subscribers is synchronized with the subscribers since one of the improvements of the Murren invention is to maintain synchronization of information publication to multiple subscribers (citing Fig. 1, [0005] to [0025]). Although *admitting* Murren et al. fail to disclose a data network using a multicast communication transport layer and a print-ready document transmission medium, the Examiner further argues that print-ready document scenario is well known in the art as evidenced by the background of the invention, as well "multicasting" as taught by Marks et al. and further adds that Marks et al.

network technology shares the same field of endeavor as Murren and instant invention, culminating in the rejection of claims 1 and 16.

The Applicant respectfully asserts that the Examiner's arguments are moot in light of amended claims 1 and 16, as described in the rejections under 35 U.S.C. §112, first and second paragraphs. Based in the foregoing, Applicant submits that the rejection of claims 1 and 16 are traversed based on the above arguments. The Applicant respectfully requests withdrawal of the rejections of currently amended claims 1 and 16.

## **V. Conclusion**

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the First Office Action dated August 17, 2010. The Applicant has clarified the structural distinctions of the present invention and now respectfully requests the withdrawal of the rejections under 35 U.S.C. §112, first and second paragraphs and 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned to conduct an interview in an effort to expedite the prosecution in connection with the present application.

Respectfully submitted,

Dated: August 26, 2010



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